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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,203	10/09/2001	Timothy E. Bishop	P 283694 D1056-CIP	3568
43569	7590	06/30/2005		
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/972,203

Applicant(s)

BISHOP ET AL.

Examiner

Sanza L. McClendon

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 21 and 22 is/are allowed.  
6) ☒ Claim(s) 1-4, 7-24 and 26-58 is/are rejected.  
7) ☒ Claim(s) 5, 6 and 25 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

Art Unit: 1711

**DETAILED ACTION**

***Response to Amendment***

1. In response to the Amendment received on April 14, 2005, the examiner has carefully considered the amendments. The examiner acknowledges the addition of claims 53-58.

***Response to Arguments***

2. Applicant's arguments filed April 14, 2005 have been fully considered but they are not persuasive. With respect to claims 23-24 and 26-29, as discussed in the interview conducted on April 14, 2005, after reconsideration it seems the examiner was hasty in stating claims 23-24 and 26-29 will be removed from all prior art rejections. The examiner unintentionally overlooked the "and/or" in component (b) of the above stated claims. The claims when in alternative form are found in the references, i.e., both Snowwhite references and Yamazaki et al discloses using at least one of the claimed isocyanates (isophorane diisocyanate) as a monomer component in the polyurethane acrylates.

The examiner contends that the amendment to claims has not overcome the obvious rejections under 35 USC 103(a) since all references teaches that the preferred backbone for the acrylate oligomer is derived from a polyether polyol. Additionally it is deemed that claims 53-56 are also read in and/or inherent to the reference and therefore these will be added to the pending prior art rejections.

With respect to claims 16-17, after reconsideration, the examiner deems the arguments are not convincing. The reasoning found in the Remark, filed April 14, 2005, are not convincing. While it is clear that the examples are for the sake of argument to a great extent similar, except for photoinitiator weight percents and the reactive diluent in the examples when compared to the comparative examples, applicant cannot make what appears evident from the disclosure (in this case the examples) the basis for insertion into the claims, especially when it is contrary what is clearly expressed and understandable (i.e., clear for an artisan of ordinary skill in the art to use and/or make the claimed invention) in the teachings of the specification—applicant is referred page 38. All amendments to the specification, including the claims and the drawing, filed after the filing date of the application must conform to the disclosure as it was at the time of the filing of the application—see 37 CFR 1.53(b). The original disclosure on page 38 states an "identical composition" and "an equal amount".

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the claims appears not to correspond with applicant's disclosure of page 38. Page 38 reads such that the composition according to applicant's invention cures faster than an **identical** comparable composition except that the 3 photoinitiators of the instant inventive composition has been replaced with an **equal amount** of 1-hydroxy-cyclohexyl-phenyl-ketone photoinitiator. While the examiner appreciates the showing of the unexpected results, applicant's teachings in the disclosure (page 38) would not have reasonably guided an artisan of ordinary skill in the art to use and/or make the composition as suggested by applicant's results and/or arguments.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-4, 7-9, 12-20, 23, and 26-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowwhite et al (6,136,880).
7. Claims 1-4, 8-9, 12-16, 19-20, 23-24 and 26-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowwhite et al (6,359,025).
8. Claims 1, 3-4, 8-9, 13-20, 23, 26-28, and 30-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al (6,057,034).

Art Unit: 1711

9. Claims 1, 3, 8, 10-20 and 30-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moschovis et al (4,782,129).

***Allowable Subject Matter***

10. Claims 5-6 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a radiation curable oligomer having the individual proportion amounts found in claims 5-6 and 25.

12. Claims 21-22 are allowed.

13. The following is an examiner's statement of reasons for allowance: The primary reasons for allowance is the radiation curable oligomer comprising from 10-30 wt% of isophorane diisocyanate, 5-15 wt% of dicyclohexylemethane diisocyanate, 45-75 wt% of polytetramethylene glycol and 5-20 wt% of hydroxyethylacrylate, which when cured at a dose of about 4.4 mJ/cm<sup>2</sup> has a percentage reacted acrylate unsaturation of at least 60%.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

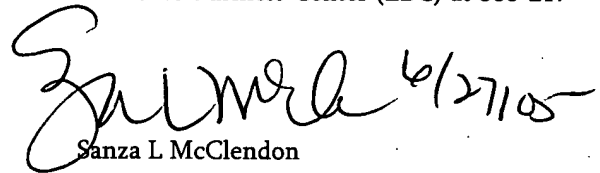
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1711

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Sanza L. McClendon", with a date "6/27/05" written to the right of the signature.

Sanza L. McClendon

Examiner

Art Unit 1711

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